

REMARKS

The present invention relates to a method for manufacturing bleached mechanical and chemithermolmechanical pulp.

It is appreciated that in the previous Office Action the Examiner indicated that claims 8-10 would be allowable if amended to overcome the rejection under 35 U.S.C. § 112, second paragraph, to address the rejections with respect to the "drastic condition with respect to the aspect of temperature" and "minimized oxygen access". Claim 8 has been accordingly been amended herein to clarify the recitation, including specifying the temperature range of 70 to 130°C suggested as supported by the Examiner. Accordingly, it is respectfully submitted that independent claim 8, and claims 9 and 10 which depend thereon, should be indicated as allowed.

However, regarding claim 1 - 7 and 11 -13, Applicants respectfully traverse the rejections under 35 U.S.C. § 112, with respect to the enablement issue. It is respectfully maintained that the temperature and minimized oxygen access conditions recited in independent claim 1 would be clearly understandable, and would enable a person skilled in the to practice the invention based on the specification and the examples, including by reference to the specific example embodiments described at pages 13-17.

With respect to the indefiniteness rejection of claims 1 - 7 and 11 - 13 with respect to the same terminology as noted above, the same disclosure in the specification would render the

meaning definite to a person skilled in this art. With respect to claim 11, it must be noted that indication that the temperature is “very high” is qualified by the further recitation “from a bleaching aspect”, and the indication that the solid content or concentration is “low” would be understood to be in the context of what would be normal at the location.

Accordingly, it is respectfully submitted that the present claims comply with the requirements of both the first and second paragraphs of 35 U.S.C. § 112.

With respect to the prior art rejection maintained with respect to claims 1-7 and 11-13 under 35 U.S.C. § 103(a) based on the asserted combination of alleged admitted prior art in view of the Madison reference, the West reference, and Grimsley et al reference, Applicants further respectfully submit that the art would not and could not be combined in the manner asserted by the Examiner by a person of ordinary skill in the art. It is only by hindsight reconstruction that such a conclusion has been reached by the Examiner.

The Examiner has referred to MPEP 2129 with respect to the consideration of what is admitted prior art based on the use of the Jepson claim format. However, the combination of known feature with features that have not been used together therewith previously can, and in the present case does, constitute a novel and unobvious combination.

The Examiner has previously recognized that the admitted prior art based on Jepson preamble recitation does not include disclosure of expressly adding bleaching agent at a location downstream of the most downstream refiner, and upstream of the screening department. Furthermore, the Examiner has previously recognized that the bleaching of the pulp under the drastic conditions from the aspect of temperature and the given minimized oxygen accessed at the location and immediately downstream of the location are not known in the admitted prior art.

With respect to the secondary and tertiary references cited by the Examiner, the Examiner has previously recognized that the Madison et al reference does not disclose expressly bleaching the pulp under the claim-required drastic condition with respect to temperature and minimized oxygen access at the noted location and immediately downstream thereof. The Examiner has also recognized that the West reference does not disclose expressly minimized oxygen access at the noted location and immediately downstream thereof. However, although the Examiner makes assumptions in order to rely on Madison et al in combination with the West reference as disclosing bleaching pulp under drastic conditions and temperature, the Examiner must furthermore rely on yet a third reference to defined all features recited in claim 1, viz., Grimsley et al, as disclosing minimized oxygen access at the noted location immediately downstream thereof.

What is still lacking however, is an explanation as to how a person of ordinary skill in the art would be lead to choose just those selected features of the secondary and tertiary references,

while ignoring other disclosure of those references, to arrive at the presently claimed invention. There is no basis in the teachings that would lead a person of ordinary skill thereto. Thus, it is only hindsight that leads to a conclusion of obviousness of claims 1 - 7 and 11 - 13.

Accordingly, withdrawal of the rejection of the claims 1-7 and 11-13 is respectfully submitted to be proper.

Regarding the title, since the present title corresponds closely to the claimed invention, it is believed to be adequately descriptive. However, Applicants' representative would be glad to discuss this further with the Examiner if it is considered necessary to allowance of the application.

In view of the foregoing amendments to the specification and claims, and foregoing remarks, Applicants respectfully submit that the present application, including not only claims 8 - 10, but also claims 1 - 7 and 11 - 13, is now in condition for immediate allowance.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby earnestly solicited.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No.: 09/914,650

Attorney Docket No.: Q66048

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local Washington, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

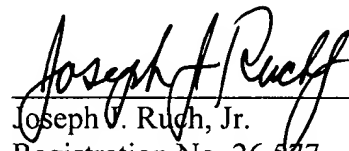
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER



Joseph V. Rugh, Jr.
Registration No. 26,577

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